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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,799	12/28/2000	Albert Y. Teng	42390P10833	9363

8791 7590 09/01/2005

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EXAMINER

MIZRAHI, DIANE D

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,799

Applicant(s)

TENG ET AL.

Examiner

DIANE D. MIZRAHI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DIANE MIZRAHI
PRIMARY EXAMINER

8/24/05

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In view of the Appeal Brief filed on June 2, 2005, PROSECUTION IS
HEREBY REOPENED. See new rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of
the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a
reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31
followed by an appeal brief under 37 CFR 41.37. The previously paid notice of
appeal fee and appeal brief fee can be applied to the new appeal. If, however,
the appeal fees set forth in 37 CFR 41.20 have been increased since they were
previously paid, then appellant must pay the difference between the increased
fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening
prosecution by signing below:

A handwritten signature in black ink, appearing to read 'J. Gaffin', is written over a horizontal line.

JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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III. DETAILED ACTION

Claims 1-15 are presented for examination.

In response to Applicants Appeal Brief, all previous presented rejections of the claims are hereby withdrawn as to being moot.

Specification

The disclosure is objected to because of the following informalities:

The disclosure is objected to because:

The disclosure contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Applicant's newly submitted Abstract has an error e.g. "off" .

Also, Applicant is reminded of the proper content of an abstract of the disclosure.

An... abstract is a concise statement of the technical disclosure ... of the patent application and should include that which is new in the art to which the invention pertains. If the patent application is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent application is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical

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disclosure of the improvement. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-2, 4 , 6, -7, 9, 11-12 and 14, is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The limitation, "identifying" is missing critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). There appears to be a

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step missing between the claimed "storing" and "identifying". How is Applicant "identifying" without searching, analyzing, generating, creating, quering, etc.?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-9 and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is unclear as to what Applicant meant by the limitation, "suited". Examiner requires a clear and concise description and clarification of the above limitations.

Claims 1, 6 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is unclear as to what Applicant meant by the limitation, "a plurality of search engines". "What is "a plurality of search engines"? Examiner requires a clear and concise description and clarification of the above limitations.

Claim Rejections - 35 USC . 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, directed towards an abstract idea.

The Supreme Court has repeatedly held that abstractions are not patentable. "An idea of itself is not patentable". Rubber-Tip Pencil Co. V. Howard, 20 Wall. 498, 07. Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work Gottschalk v. Benson, 175 USPQ 673, 675 (S Ct 1972). It is a common place that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter Parker v. Flook, 197 USPQ 193, 201 (S Ct 1978). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed.

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Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

Claims 1-5 represents an abstract idea that does not provide a practical application in the technological arts. There is no manipulation of data nor is there any transformation of data from one state to another state being performed in "A method comprising. Actually, no post-computer process activity is found in the technological arts. "A method comprising" is not a physical transformation. Thus, no physical transformation is performed, no practical application is found. Also, the claims do not appear to correspond to a specific machine or manufacture disclosed within the specification and thus encompass any product of the class configured in any manner to perform the underlying process. Consequently, the claims are analyzed based upon the underlying process, and are thus rejected as being directed.

Claims 6-15 and are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, "a machine-readable medium" should read "a machine-readable storage medium storing instructions".

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Claim Rejections - 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheth et al. (US Patent No. 6,311,194 B1 and Sheth hereinafter) in view of Belfiore et al. (U.S. Patent# 6,009,4569 and Belfiore hereinafter).

Regarding claims 1, 6 and 11, Seth teaches storing a plurality of content categories (col 2, lines 13-23) see also (col 3, lines 36-49); and identifying, according to properties ... at least one search engine suited to service a query at least one content category of the plurality of content categories (col 3, lines 36-50).

Sheth does not teach a plurality of search engines.

Belfiore teaches a plurality of search engines (i.e. plurality of search engines) (col 2, lines 44-47).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to

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modify the teachings of Seth with the teachings of Belfiore to include a plurality of search engines with the motivation to automatically retrieve information regarding appropriate web sites so that the user can gain access to the desired web site....and also helps to increase the resilience of the system to user input) (Belfiore, col 4, lines 35-40).

Regarding Claims 2, 7 and 12, Sheth teaches identifying at least one domain of the at least one search engine suited to service the query (col 3, lines 51-56) see also (col 2, lines 13-24).

Regarding Claims 3, 8 and 13, Sheth teaches analyzing the content of a query to determine at least one content category of the query (col 7, lines 45-64) see also (col 16, lines 37-55) and identifying at least one domain of the at least one search engine suited to service the query according to the content category (col 3, lines 36-50).

Regarding Claims 4, 9 and 14, Sheth teaches identifying the at least one domain according to a scope of the query (col 3, lines 36-50) see also (col 9, lines 38-59).

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Regarding Claims 5, 10 and 15, Sheth teaches child categories (i.e. the parent is "sportsasset" and the child is either football or basketball or golf) (Figure 1).

Comments

The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Other Prior Art Made of Record

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not

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be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 873-8300 for regular communications and (703) 305-3900 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read "Diane Mizrahi", is written over a horizontal line.

Diane Mizrahi
Primary Patent Examiner
Technology Center 2100

August 26, 2005